



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,272	11/18/2003	Jeffrey W. Baxter	04131.P005C2	9995

7590 03/07/2005

James C. Scheller, Jr.
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

JOHNSON III, HENRY M

ART UNIT PAPER NUMBER

3739

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,272

Applicant(s)

BAXTER ET AL.

Examiner

Henry M Johnson, III

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 111803.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The information disclosure statement filed 11/18/03 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered. The form must have space for the examiner to initial and must have the correct application number on each page.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12, 14-35 and 37-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4 and 6-27 of U.S.

Art Unit: 3739

Patent No. 6,428,539. Although the conflicting claims are not identical, they are not patentably distinct from each other because are an obvious modification of scope.

Claims 1-8, 10-17, 19, 22, 25, 28, 29 and 36-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 8-18 of U.S. Patent No. 6,702,813. Although the conflicting claims are not identical, they are not patentably distinct from each other because are an obvious modification of scope.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7, 10, 14, 15, 28, 42 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,810,809 to Rydell. Rydell discloses a rotary cutting tool with electrocautery capability with a handle (Fig. 1, #14), an outer tube with a cutting edge (blade) on its distal end (Fig. 2, #20) the outer tube coaxially surrounding an inner tube conductive metal cutting member (Col. 4, lines 31-35). The cutting edges of both tubes are interpreted as the sharp edges of the windows associated with each (Col. 3, lines 54-56). These edges are disclosed to operate in a cooperative manner in claim 13. The inner tube includes a lumen (Col. 5, line 12) and the outer tube may be energized electrically (Col. 5, lines 43-45). The inner tube rotates within the outer tube (Col. 3, lines 40- 43). With neither the handle nor the outer tube rotating, it is inherent that that are connected in some manner. Either the inner or outer tube may have serrated edges (Col. 4, line 64). The method of use is disclosed as drawing tissue

Art Unit: 3739

into the opening, an act requiring positioning of the instrument, rotating the blades to cut the tissue and applying electrocautery (Col. 5, lines 45-60).

Claims 16, 19-22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,112,299 to Pascaloff. Pascaloff teaches an instrument with an elongated outer sheath member (tube) having substantially fully open distal and proximal ends, and an inner hollow cylindrical cutting blade member rotatable within the sheath member. The cutting blade member has a distal end that is substantially fully open (lumen). The cutting blade member and the sheath member are each provided with a pair of spaced longitudinally extending, diametrically opposed tabs at their corresponding distal ends. Cutting edges are formed on each of the tabs on the cutting blade member and the sheath member and extend to the free ends of each member. The cutting edges on the cutting blade member are cooperable with the corresponding cutting edges on the sheath member (Abstract). The cutting edges may be serrated (Col. 2, line 64). Both the inner and outer elements have multiple cutting edges (Fig. 4) and both elements are associated with a handle (Fig. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,112,299 to Pascaloff as applied to claim 16 above and further in view of U.S. Patent 5,810,809 to Rydell. Both are discussed above, but Pascaloff does not disclose electrical energy applied to the cutting edges. Rydell discloses such energy. It would have been obvious

Art Unit: 3739

to one having ordinary skill in the art at the time the invention was made to energize a cutting edge taught by Rydell in the invention of Pascaloff to provide a cauterizing capability.


Motivation to combine is clearly indicated by Rydell indicating the cutting heads could take any number of configurations (Col. 3, line 43), thus meeting the unique longitudinal blades of Pascaloff.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Henry M. Johnson, III
Patent Examiner
Art Unit 3739